



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,289	01/17/2002	Stephen O. Clark	45715.830001.000	4897

26582 7590 03/24/2003

HOLLAND & HART, LLP
555 17TH STREET, SUITE 3200
DENVER, CO 80201

EXAMINER

ARYANPOUR, MITRA

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary	Application No.	Applicant(s)	
	10/053,289	CLARK ET AL.	
	Examiner	Art Unit	
	Mitra Aryanpour	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, *the strap having a detachably coupled end using snap, VELCRO strip, adhesive, buckle or suction cup (see claim 3); the rim having a lip (see claim 11); spring means used for deadening the impact of the ball (see claim 17); and a spring coupling the handle portion to the barrel portion, and means for controlling the spring (see claims 22-24)* must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The use of the trademark VELCRO has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3711

4. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 3, line 3, the use of the trademark VELCRO has been noted. It is not possible to reasonably determine what is encompassed by the trademark and what is not.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 4-11, 13-16, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Genjack (3,169,019).

Regarding claim 1, Genjack discloses at least one cup (11); at least one strap (30) attached to the cup (11), wherein the strap is adapted to secure the cup to the bat (25).

Regarding claim 2, Genjack shows the strap is detachably coupled to the at least one cup (see column 2, lines 12-35); and a length sufficient to wrap around the barrel (see figure 1).

Regarding claim 4, Genjack further shows the cup (11) is positionable along the bat (25). See figure 1.

Regarding claim 5, Genjack further shows the cup (11) having a seating surface (20) adapted to be secured adjacent to the bat (25), and sidewalls (13) having a rim, wherein the rim defines an opening (see figures 2 and 6).

Regarding claim 6, Genjack further shows the sidewalls (13) tapering generally outwardly (see figure 4).

Regarding claim 7, Genjack shows the seating surface having a substantially funnel shape (see figure 2).

Regarding claims 8 and 9, Genjack also show the opening defining a geometrical shape such in a circle (see figure 2).

Regarding claim 10, Genjack shows the seating (20) having an opening (33).

Regarding claim 11, as best seen from figures 2 and 3, Genjack shows the cup having a rim and the rim having a lip portion which has an outer, inner and transition portion and generally parallel to the bat surface (see figure 1).

Regarding claim 13, see comments for claim 1.

Regarding claim 14, Genjack further shows the device to be used for catching a ball, which would inherently direct the bat towards the ball upon impact (see column 1, lines 14-16).

Regarding claim 15, see comments for claim 4.

Regarding claim 16, Genjack's cup upon catching or impacting a ball would inherently deaden the impact of the ball on the bat.

Regarding claim 18, see comments for claim 1. Additionally, Genjack shows the cup being attached to a bat (see figure 1), wherein the bat has a handle portion, a barrel portion and an intermediate portion.

Regarding claim 20, see comments for claim 2.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 12, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Genjack (3,169,019).

Regarding claim 3, Genjack shows the strap to be a continuous loop. Official Notice is taken that modifying a continuous loop strap (one-piece) to a two-part strap would have been an obvious choice of design and it would have been obvious to do so here, since it would make the device more readily detachable.

Regarding claim 12, Genjack as disclosed above does not indicate the material to make the cup. Official Notice is taken that making the Genjack's cup (11) from well-known material such as rubber, foam, leather, metal, wood, etc. would have been an obvious choice of material, depending on the availability and the suitability of the material.

Regarding claim 19, Genjack shows the cup or bunt aid (11) to be releasably attached to the bat. It would have been obvious to one of ordinary skill in the art to have made the cup integral with the bat, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *In re Larson* 144 USPQ 347 (CCPA 1965), and it would have been obvious to do so here, since it would require less parts.

Regarding claim 21, see comments for claim 12.

Art Unit: 3711

9. Claims 13-15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Tyner (6,254,498).

Regarding claim 13, Tyner shows an instructional device (10) having means (15) to improve bunting skills; the means for simulating the catching of a ball with the bat; and means for attaching the simulating means to the bat (see column 5, lines 1-7).

Regarding claim 14, Tyner shows the simulating means (15) is positioned on the bat in order to strike a ball, therefore, it would inherently guide the bat to the ball.

Regarding claim 16, Tyner shows the means for simulating (15) would inherently deaden the impact of the ball on the bat.

Regarding claim 17, Tyner further shows the instructional device (15) adjustably positioned on a training bat (10), wherein the means to simulate is a sleeve (see figure 3).

10. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Genjack (3,169,019) in view of Huddleston (5,516,097).

Regarding claim 22-24, Genjack shows the cup or bunt aid being attached to a bat. It would have been obvious to attach the cup means (11) of Genjack to different types of bat, including one having spring means. This feature is shown by Huddleston (see figure 6). Therefore, it would have been an obvious to utilize the cup means of Genjack with other hitting implements, since the objective is to catch or throw balls with the cup, regardless of the specifics details of the bat the cup is attached to.

Art Unit: 3711

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

MA
March 19, 2003



Paul T. Sewell
Supervisory Patent Examiner
Group 3700